

Remarks

In view of the following remarks, reconsideration and further examination are respectfully requested.

No claims have been amended, canceled, withdrawn and/or added in the present response. Consequently, claims 13-17 and 20-33 are currently pending and under consideration.

Claim Rejections Under 35 USC §102

In item 2 of the Office Action, claims 24-27 and 30-33 were "rejected under 35 U.S.C. 102(e) as being anticipated by Yuzhakov et al (2002/0168290 A1)" (hereinafter referred to as "Yuzhakov '290"). As will be explained in greater detail below, the Yuzhakov '290 published application is not prior art with respect to the present application because the Yuzhakov '290 published application does not claim priority to and is not supported by the provisional applications identified in the Related U.S. Application Data section on the face of the Yuzhakov '290 published application. In particular, it does not appear that the Yuzhakov '290 published application is prior art under 35 USC §102(e) because the Yuzhakov '290 published application is not entitled to the May 10, 2001 effective filing dates of the provisional applications listed on the face of the published application. Moreover, the Yuzhakov '290 published application does not appear to actually claim priority to the provisional applications, but it appears that the provisional applications were mistakenly listed on the face of the Yuzhakov '290 published application as well as in the records on PAIR.

The present application has a U.S. filing date of August 31, 2001, and the present application claims foreign priority to German Patent Application No. 101 34 650.6, which was filed on July 20, 2001. On the Office Action Summary Sheet for the latest October 14, 2005 Office Action, the United States Patent and Trademark Office ("USPTO") acknowledged this priority claim.

The Yuzhakov '290 published application has a U.S. filing date of May 9, 2002, which is after both the August 31, 2001 U.S. filing date of the present application and the July 20, 2001 foreign priority date of the present application. Thus, based on the actual U.S. filing date of the Yuzhakov '290 published application, the Yuzhakov '290 published application is not prior art under 35 U.S.C. §102(e).

Response to Office Action  
Serial No. 09/943,080  
Group Art Unit 3736  
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Nevertheless, the Related U.S. Application Data section on face of the Yuzhakov '290 published application and the Continuity Data tab in PAIR indicate that the Yuzhakov '290 published application claims the benefit of the following provisional applications: U.S. Provisional Application No. 60/290,139, filed on May 10, 2001; U.S. Provisional Application No. 60/290,140, filed on May 10, 2001; and U.S. Provisional Application No. 60/290,156, filed on May 10, 2001. It is believed that the Examiner can readily access the electronic files for these provisional applications, so copies of these provisional application files have not been enclosed, but they can be supplied to the Examiner, if needed. One of the first curious things is that the titles are not similar between the provisional applications and the Yuzhakov '290 published application. The provisional applications have titles like "Antibiotic AA-896 Analogs" and "Antibiotics AA-896" that are not remotely related to the "Physiological Sample Collection Devices And Methods Of Using The Same" title of the Yuzhakov '290 published application. The second curious item is that the provisional applications do not have one inventor in common with the Yuzhakov '290 published application. This means that, unless some petition has been filed to create common inventorship, the Yuzhakov '290 published application cannot properly claim priority to the provisional applications.

When you review the file history, the Yuzhakov '290 published application apparently does not claim priority to the provisional applications. The signed declaration and the filed application data sheet (ADS) do not list any related applications. In addition, the first paragraph of the specification for the Yuzhakov '290 published application does not (and was not amended to) contain a claim of priority to the provisional applications. It therefore appears that the priority information for the Yuzhakov '290 published application contained in the USPTO's records is incorrect, and it might be advisable to correct the priority claim for the Yuzhakov '290 published application. In other words, there seems to be a glitch in the USPTO's records as embodied by the listing of the provisional applications in the priority section of the Yuzhakov '290 published application. Given that the Yuzhakov '290 published application does not share a common inventor with the provisional applications and does not appear to in fact claim priority to the provisional applications, the Yuzhakov '290 published application is not entitled to the May 10, 2001 priority date of the provisional applications listed on the face of the Yuzhakov '290 published application. Thus, the Yuzhakov '290 published application is not 35 U.S.C. §102(e) prior art with respect to the present application.

Response to Office Action  
Serial No. 09/943,080  
Group Art Unit 3736  
CPS Inc 36Q014

Assuming for the sake of argument that the Yuzhakov '290 published application could claim priority to the provisional applications, the provisional applications would still fail to provide any support for the features described and illustrated in the Yuzhakov '290 published application. None of the drawings in the provisional applications are even remotely similar to the drawings in the Yuzhakov '290 published application. Likewise, the specifications of the provisional applications describe a technology that is completely different from the technology described in the Yuzhakov '290 published application. Although the provisional application's specifications are rather complex, it looks like the provisional applications describe some type of antibiotic, which is completely different from the sample collection device described in the Yuzhakov '290 published application. Therefore, the provisional applications fail to provide any support for the Yuzhakov '290 published application, and as a result, the Yuzhakov '290 published application is only entitled to its May 9, 2002 filing date. To reiterate, since the May 9, 2002 filing date of the Yuzhakov '290 published application is after the August 31, 2001 U.S. filing date of the present application (as well as after the July 20, 2001 foreign priority date) of the present application, the Yuzhakov '290 published application cannot be 35 U.S.C. §102(e) prior art with respect to the present application. For these and other reasons, it is respectfully requested that the rejection under item 2 of the Office Action be withdrawn.

Claim Rejections Under 35 USC §103

In item 4 of the Office Action, claim 28 was "rejected under 35 U.S.C. 103(a) as being unpatentable over Yuzhakov et al (2002/0168290 A1) as applied to claim 24 above and further in view of Ramel (5,540,709)." In item 5, Claim 29 was "rejected under 35 U.S.C. 103(a) as being unpatentable over Yuzhakov et al (2002/0168290 A1) as applied to claim 24 above, and further in view of Eriksen (2,359,550)." In item 6, Claims 13-17 and 20-23 were "rejected under 35 U.S.C. 103(a) as being unpatentable over Yuzhakov et al (2002/0168290) in view of Garcia et al (4,637,403)." Given that all of these rejections are based the Yuzhakov '290 published application, which is not prior art with respect to the present application (as explained above), it is requested that the rejections of items 4, 5, and 6 be withdrawn.

February 11, 2005 Information Disclosure Statement

Again, it should be noted that an Information Disclosure Statement (IDS) was submitted on February 11, 2005. A copy of the IDS has not been again supplied since it appears on both public and private PAIR. It is respectfully requested that an initialed copy of this IDS be returned in the next communication from the Patent Office.

Supplemental Application Data Sheet

A Supplemental Application Data Sheet (ADS) was submitted with the last response (August 22, 2005) in order to update the spelling of an inventor's first name as well as to update the docket number, power of attorney and correspondence address information. In particular, it was requested that the attorney docket number be changed to "7404-727". In addition, it was requested that the first name for Mr. Koehler be corrected to "Karl-Heinz." In accordance with MPEP 201.03 and 601.05, it was believed that the ADS satisfied the requirements to correct the spelling of an inventor's name, and therefore, a supplemental declaration was not required. A Notice of Acceptance of Power of Attorney has been received in which the power of attorney and correspondence address was updated. However, the attorney docket number has not been updated, and based on the publication review information on private PAIR, it does not appear that Mr. Koehler's first name has been updated. In accordance with the August 22, 2005 ADS, it is respectfully requested that the USPTO update its records with respect to the attorney docket number and Mr. Koehler's first name.

Response to Office Action  
Serial No. 09/943,080  
Group Art Unit 3736  
RPS 1a 168014

Conclusion

For at least the reasons discussed above, all of the pending claims in present application are in condition for allowance, and as a result, the present application is in condition for allowance and an early notice of allowance is earnestly solicited. It should be understood that the above remarks are not intended to provide an exhaustive basis for patentability or concede the basis for the rejections in the Office Action, but are simply provided to overcome the rejections made in the Office Action in the most expedient fashion. If after reviewing this response the Examiner feels that any issues remain which must be resolved before the application can be passed to issue, the Examiner is invited to contact the undersigned representative by telephone to resolve such issues.

Respectfully submitted,

By \_\_\_\_\_

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Response to Office Action  
Serial No. 09/943,080  
Group Art Unit 3736  
CPS.Ic 369014

Page 10 of 10

PAGE 11/11 \* RCV'D AT 1/13/2006 3:21:26 PM [Eastern Standard Time] \* SVR:USPTO-EFXRF-6/41 \* DNI:2738300 \* CSID:3176377561 \* DURATION (mm:ss):03:36